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Mailed:
March 16, 2004

Paper No. 6
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Cadence Group, Inc.
v.
Cadence Media Group, L.C. (L.L.C.)

Opposition No. 91151811
to application Serial No. 76115714
filed on August 24, 2000

Edmund B. Burke for The Cadence Group, Inc.

Wade R. Budge of Snell & Wilmer for Cadence Media Group,
L.C. (L.L.C.).

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

In the above-referenced application, applicant seeks registration on the Principal Register of the mark CADENCE MEDIA GROUP (in typed form) for services recited in the application (as amended) as "graphic art design; multimedia and graphic art design and development services, namely, designing and developing websites, e-commerce businesses, closed-computer networks, extranets, and on-line stores for

others," in Class 42. Applicant has disclaimed the exclusive right to use MEDIA GROUP apart from the mark as shown.

Opposer has opposed registration of applicant's mark, alleging as grounds therefor that applicant's mark, as applied to applicant's services, so resembles opposer's mark CADENCE GROUP, previously used in connection with and registered for "business management and consultation, business research, temporary employment and job placement, and general information clearinghouse services" in Class 35; "document and message retrieval and delivery by non-electronic means" in Class 39, and "computer consulting, library consultation services and legal research services, excluding design of new products for others in the field of electronics, and excluding consulting services in the field of electronic product design and electronic product implementation" in Class 42, as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

The evidence of record includes the file of applicant's involved application,¹ the pleadings herein, and a status

¹ However, any factual allegations in the application which were made by applicant during ex parte prosecution of the application

and title copy of opposer's pleaded Registration No. 2,354,530 of the mark CADENCE GROUP (in typed form) for the above-quoted services, which opposer made of record via notice of reliance. The registration was issued on June 6, 2000, and it includes a disclaimer of the exclusive right to use GROUP apart from the mark as shown.

Opposer filed a brief on the case, but applicant did not. No oral hearing was requested.

Because opposer has made of record a status and title copy of its pleaded registration, and because its likelihood of confusion claim is not without merit, we find that opposer has established its standing to oppose registration of applicant's mark. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Additionally, because opposer has made its pleaded registration of record, priority is not an issue in this case with respect to the mark and services identified therein. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Therefore, the only issue to be decided is whether opposer has established that a likelihood of confusion exists.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion

are not deemed to be evidence of record in this proceeding. *See*

factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to a determination of whether applicant's mark and opposer's registered mark, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re*

TBMP §704.04 (2d ed. June 2003).

National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find that applicant's mark and opposer's mark are quite similar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. Indeed, the marks are identical but for the presence of the descriptive word MEDIA as the second word in applicant's mark. Both marks begin with the word CADENCE and end with the word GROUP. The dominant feature in both marks is the first word CADENCE, which appears to be arbitrary or at most only slightly suggestive as applied to the respective services. The strength of the term CADENCE in opposer's mark is further established by the absence of any evidence of third-party use of CADENCE or similar marks on or in connection with the services at issue herein. The remaining wording in each mark, i.e., MEDIA GROUP and GROUP, respectively, is descriptive matter. We find that any dissimilarities between the marks which result from the presence of the word MEDIA in applicant's mark and the absence of that word from opposer's mark are greatly outweighed by the similarity which results from the fact that both marks start with the word CADENCE and end with the word GROUP.

We turn next to a determination of the similarity or dissimilarity of the services recited in applicant's application and opposer's registration, respectively. It is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between applicant's mark and opposer's mark, the lesser the degree of similarity between applicant's services and opposer's services that is required to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Opposer argues that the "computer consulting" services identified in its registration are similar to and related to the "designing and developing websites, e-commerce businesses, closed-computer networks, extranets, and on-line stores for others" recited in applicant's application. Opposer contends that these services of applicant's all "involve the design and development of computer programs, based on a consulting project commissioned by the customer. As such, they are no more than a form of computer consulting." (Brief at 4.) Opposer continues:

"Computer consulting" involves assisting a customer in achieving a result desired, using computer technology, whereby the consultant applies skill and expertise to achieve a desired end. Opposer's mark is registered for this service. The service claimed by Applicant logically entails the performance of this very service, as none of the activities claimed by Applicant could be carried out without substantial work in consulting on the computer implementation of the work.

(Brief at 5.)

We find that the services recited in applicant's application are sufficiently related to the services recited in opposer's registration that confusion is likely to result from the parties' use of the similar marks involved herein. The "designing and developing websites, e-commerce businesses, closed-computer networks, extranets, and on-line stores for others" recited in applicant's application are

encompassed within the "computer consulting" services recited in opposer's registration. This is especially so with respect to applicant's design and development of "closed-computer networks" and "extranets."² Moreover, the "business management and consultation" services recited in opposer's registration encompass applicant's services of designing and developing "e-businesses" and "on-line stores." Although the scope and focus of applicant's services is narrowed by the prefatory language in applicant's recitation of services, i.e., "multimedia and graphic art design services, namely," applicant's services still are within the ambit of opposer's recited services.

We also find that the parties' respective services are likely to be marketed in the same trade channels and to the same classes of purchasers, i.e., companies large and small which utilize computer intranets and extranets, as well as the World Wide Web, to conduct their businesses. Although the parties' respective services are likely to be purchased with some degree of care, we cannot conclude that the degree

² "Extranet" is defined as "an intranet (internal TCP/IP network) that has been selectively opened to a firm's suppliers, customers and strategic allies" (Webster's New World Dictionary of Computer Terms (8th ed. 2000)), and as "an extension of a corporate intranet using World Wide Web technology to facilitate communication with the corporation's suppliers and customers. An extranet allows customers and suppliers to gain limited access to a company's intranet in order to enhance the speed and efficiency of their business relationship" (Microsoft computer Dictionary (5th ed. 2002)). The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C.*

of such care would be so great that it negates the likelihood of confusion as to source, sponsorship or affiliation which would be caused by the use of these highly similar marks.

In summary, we find that applicant's mark and opposer's mark are confusingly similar because they both start with the arbitrary word CADENCE and end with the word GROUP. Indeed, the marks are identical but for the presence of the descriptive word MEDIA in applicant's mark. Even assuming that purchasers are able to perceive and recall this sole point of distinction between the marks, the parties' services are sufficiently related that purchasers are likely to assume that a source, sponsorship or other relationship exists. Purchasers aware of CADENCE GROUP and its computer consulting and business management consulting services, upon encountering the mark CADENCE MEDIA GROUP used in connection with the design and development of websites, e-commerce businesses, closed-computer networks, extranets and online stores, are likely to assume that CADENCE MEDIA GROUP is an affiliate or division of CADENCE GROUP which specializes in these particular computer- and multimedia-based development and design services.

Having carefully considered all of the relevant *du Pont* factors, we conclude that a likelihood of confusion exists.

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Any doubt as to this result must be resolved against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The opposition is sustained.

F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01.